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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/009,229

11/06/2001

Chisato Hirata

ACE-1001

5572

7590

06/13/2006

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EXAMINER

MAI, TRI M

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,229

Applicant(s)

HIRATA, CHISATO

Examiner

Tri M. Mai

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-17 and 19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-T449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/26/05</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Claims 13--17, and 19 are objected to. "perform" should be --preform--.
2. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker (D187435) in view of Ota et al. (5238129) or Carew et al. (6044996). Becker teaches a container with a main body comprising a base portion and an ornamental portion. The ornamental shape of a figurine shape of an animal with head and torso portion divided by a narrow portion. Becker meets all claimed limitations except for the bottle is made from PET, the cap, and the base portion is provided with decompression panels. Either of Ota or Carew teaches that it is known in the art to make a container from thermoplastic material and to provide decompression panels. It would have been obvious to one of ordinary skill in the art to provide decompression panels in Hager as taught by either Ota or Carew to enable one to manufacture the bottle easily.

With respect to the cap, the container in Becker would inherently having a cap as claimed. To the degree it is argued that there is no cap in Becker, it would have been obvious to one of ordinary skill in the art to provide a cap to close the bottle.

With respect to the elliptical cross section and the gradual curved portion. It is noted there is a gradual curved portion about the neck. Furthermore, it would have been obvious to one of ordinary skill in the art to provide a figurine with an elliptical cross section to provide the desired figurine for the container. Furthermore, It is noted that matter relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

3. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Ota et al. (5238129) or Carew et al. (6044996) in view of either Becker or Hager. It would have been obvious to one of ordinary skill in the art to provide the figurine on top of body portion in either Ota or Carew as taught by either Becker or Hager to attract consumer.

With respect to the cap, the container in either Ota or Carew would inherently having a cap as claimed. To the degree it is argued that there is no cap in Ota or Carew, it would have been obvious to one of ordinary skill in the art to provide a cap to close the bottle.

With respect to the elliptical cross section and the gradual curved portion. It is noted there is a gradual curved portion about the neck in either Becker or Hager. Furthermore, it would have been obvious to one of ordinary skill in the art to provide a figurine with an elliptical cross section to provide the desired figurine for the container. Furthermore, It is noted that matter relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

4. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over any of the rejections of Becker, Ota and Carew, as set forth in paragraphs 2 and 3, and further in view of JP 952570 or Kolb (D192390). It would have been obvious to one of ordinary skill in the art to provide a cap in the shape of a hat as taught JP'570 or Kolb to simulate the container.

5. Claims 13, 14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0879765, or in the alternative, over EP '765 in view of Becker. It would have been obvious to one of ordinary skill in the art to provide a figurine with a torso as taught by Becker to provide an alternative figure for attracting the children. It would have been obvious to one of ordinary

Art Unit: 3727

skill in the art to provide the figurine of Becker with an elliptical cross section to provide the desired shape for the container. Furthermore, It is noted that matter relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP '765 rejection, as set forth in paragraph 4, and further in view of either Ota or Carew. To the degree it is argued that EP '765 does not teach the recess portion being arcuate surface and the panels are rectangular. It would have been obvious to one of ordinary skill in the art to provide the decompression panels in either Ota or Carew to provide alternative compression panels.

7. Claims 15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP'765 rejection of as set forth above, and further in view of JP 952570 or Kolb (D192390). It would have been obvious to one of ordinary skill in the art to provide a cap in the shape of a hat as taught JP'570 or Kolb to simulate the container.

8. Applicant's arguments have been fully considered but they are not persuasive. With respect to the new limitation that the bottle is manufactured by placing the heated prefom in a blow mold. The examiner submits that the patentability of a product does not depend on its method of production. If the product in the product - by - process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe , 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. In this case, the process as claimed does not impart any structure over the bottle of Beck in view of either Ota and Carew.

Art Unit: 3727

With respect to the elliptical cross section, applicant asserts that the elliptical cross section offer a varied fluid flow pattern when compared to a circular shape. It is noted that the specification fails to mention any of these assertion that the elliptical cross section offer a varied fluid flow pattern. Furthermore, it is noted that applicant admit that these ornaments can be substitute with other ornament and that they are equivalents.

Further, although the ornamental portion 10 is formed in an animal shape, it is not limited to the shape and can be modified in various shapes such as a human shape, an automobile shape and a rocket shape. If the ornamental portion 10 is formed in an animal shape, a human shape or the like, it particularly stimulates eagerness to purchase of children and the PET bottle 1 can be used as a toy after a soft drink is consumed. (pg. 8, ln. 10-16)

Furthermore, the examiner submits that there is no functionally different between a elliptical cross section and a circular cross section at all. Since ornament as claimed are so vary with respect to the various cross sections along the ornament that would provide no functional differences with other ornaments.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art to provide

Art Unit: 3727

decompression panels in Hager as taught by either Ota or Carew to enable one to manufacture the bottle easily.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (571)272-4541. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W Young can be reached on (571)272-4549. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3727

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tri M. Mai
Primary Examiner
Art Unit 3727

